REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-15 are currently pending. Claims 1, 5, and 9 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 6 of U.S. Patent No. 6,631,247 to Motoyama et al. (hereinafter "the '247 patent") in view of U.S. Patent No. 5,935,262 to Barrett et al. (hereinafter "the '262 patent"); Claims 1 and 3 were rejected under the judicially created doctrine of obviousness-type patenting as being unpatentable over Claim 1 of U.S. Patent No. 5,544,289 to Motoyama (hereinafter "the '289 patent") in view of the '262 patent; Claims 1, 5, and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,236 to Hashimoto et al. (hereinafter "the '236 patent") in view of U.S. Patent No. 5,184,179 to Tarr et al. (hereinafter "the '179 patent"); Claims 4, 8, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '236 and '179 patents, further in view of U.S. Patent No. 5,901,286 to Danknick et al. (hereinafter "the '286 patent"); and Claims 1, 5, and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '262 patent.

Amended Claim 1 is directed to a method of monitoring at least one network device communicatively coupled to a network, comprising: (1) obtaining, by a first computer over the network, device information of the at least one network device, the device information including status information obtained from sensors of the at least one network device and a device identification; (2) storing the obtained device information; (3) processing the stored device information to generate a period usage report for the at least one network device; (4)

transmitting the usage report from the first computer to a second computer; and (5) receiving the usage report by the second computer. Further, amended Claim 1 recites that the first computer is remote from the at least one network device, and the first computer is the first computer to obtain the device information from the at least one network device. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.[1]

Applicants respectfully submit that the rejection of Claim 1 based on the judicially created doctrine of obviousness-type double patenting with respect to the '247 patent is rendered moot by the terminal disclaimer filed herewith.

Applicants respectfully traverse the rejection of Claims 1 and 3 under the judicially created doctrine of obviousness-type double patenting over claims in the '289 patent. Claim 1 of the '289 patent is directed to storing and transmitting semi-static data that includes data which may change infrequently over a life of a business office device. However, Applicants respectfully submit that the '289 patent fails to disclose the step of storing status information obtained from sensors of at least one network device, and processing stored device information to generate a period usage report for the at least one network device, as recited in amended Claim 1. Further, Applicants respectfully submit that the '289 patent fails to disclose that the first computer is the first computer to obtain the device information from the at least one network device, as recited in amended Claim 1. Further, Applicants note that the '262 patent fails to disclose obtaining, by a first computer remote from the network device, device information of the network device, as recited in amended Claim 1. Rather, as discussed below, the '262 patent discloses a system in which a network expansion device (NED 1001) is directly connected to the network device. Moreover, Applicants respectfully submit that the '262 patent fails to disclose a first computer that is the first computer to obtain

[1] See, e.g., Figures 11 and 25-28 and the discussion related thereto in the specification.

the device information from the at least one network device, wherein the device information is obtained by the first computer over a network.

Accordingly, no matter how the teachings of the '289 and '262 patents are combined, the combination does not teach or suggest the limitations recited in amended Claim 1. In this regard, Applicants note that the Office Action asserts that the storing, processing, and remote limitations recited in Claim 1 do not make Claim 1 patentably distinct from '289 Claim 1. However, Applicants submit that the Office Action fails to provide any evidence to support this assertion. Moreover, Applicants respectfully submit that, in an obviousness type rejection, the Office Action must show how each claimed limitation is disclosed in the prior art, as well as motivation to combine the prior art references. Since the Office Action failed to do this and only stated generally that certain claimed limitations are obvious, Applicants respectfully submit that a *prima facie* case of obviousness type double patenting has not been established and that the rejection should be withdrawn.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '236 patent discloses everything in Claim 1 with the exception of obtaining, by a first computer over the network, the device information of the at least one network device, and relies on the '179 patent to remedy that deficiency.

The '236 patent is directed to a communication control device connected between an image forming apparatus and a communication line that connects the image forming apparatus to a host machine. The '236 patent discloses that "the control device 18 is inserted in the user's existing communication line."[2] However, as admitted in the Office Action, the '236 patent fails to disclose obtaining, by a first computer over the network, device information of the network device, as recited in amended Claim 1. Further, Applicants respectfully submit that the '236 patent fails to disclose processing stored device information

[2] '236 patent, col. 6, lines 7-9.

to generate a period usage report for the at least one network device, as recited in amended Claim 1. Rather, the '236 patent merely discloses that total counter value data received from the image forming device can be stored in the communication control device and then sent to the host machine when requested or at a particular time.

The '179 patent is directed to a system for monitoring a variable output paper processing device. As shown in Figs. 1 and 2, the '179 patent discloses a computer control 16, which includes a monitoring CPU 24, directly connected to the copier. Further, the '179 patent discloses that the counter detector 18 counts the number of pages processed and transmits that count to the computer control 16, which stores the information until a predetermined time and then transmits that information to a billing center at predetermined intervals. Further, the '179 patent discloses that the computer control 16 is the first computer to obtain the device information from the copier. However, Applicants respectfully submit that the '179 patent fails to disclose that the computer control 16 is configured to obtain, over the network, device information for at least one network device, wherein the computer control 16 is the first computer to obtain the device information from the network device. Further, as shown in Figure 2, Applicants note that the control 46 disclosed by the '179 patent is not the first computer to obtain the device information from the copier.

Accordingly, no matter how the teachings of the '236 and the '179 patent are combined, the combination does not teach or suggest the step of obtaining, by a first computer over the network, device information of the at least one network device, wherein the first computer is remote from the at least one network device, and the first computer is the first computer to obtain the device information from the at least one network device, as recited in amended Claim 1. Accordingly, Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 2 and 3) is rendered moot by the present amendment to Claim 1.

Independent Claims 5 and 9 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 5 and 9 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 5 and 9 (and all similarly rejected dependent claims) are rendered moot by the present amendment to Claims 5 and 9.

Regarding the rejection of dependent Claims 4, 8, and 12 under 35 U.S.C. § 103(a), Applicants respectfully submit that the '286 patent fails to remedy the deficiencies of the '236 and '178 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of Claims 4, 8, and 12 are rendered moot by the present amendment to independent Claims 1, 5, and 9.

Applicants respectfully traverse the rejection of Claim 1 under 35 U.S.C. § 103 as being unpatentable over the '262 patent.

The '262 patent is directed to a network device that interfaces between a local area network and an image forming apparatus. As shown in Figure 1, the '262 patent discloses a printer 102 that has a network expansion device (NED) 1001 directly attached to the printer 102. Further, the '262 patent discloses that the NED 1001 can transfer information about the printer status to a local area network. However, Applicants respectfully submit that the '262 patent fails to disclose the step of obtaining, by a first computer over the network, device information of the at least one network device, including status information obtained from sensors of the at least one network device, as recited in Claim 1. Moreover, the '262 patent fails to disclose that the NED 1001 is remote from the printer 102. Rather, the '262 patent discloses a system in which a network expansion device is directly connected to the network device. In this regard, Applicants note that the Office Action refers to column 1, lines 51-65 as disclosing that the first computer is remote from the network device. However, Applicants

note that that passage from the '262 patent is directed to a description of the related art and merely discloses that a second computer can be remote from the first computer, which in this case is directly connected to a peripheral device such as a printer. This description is consistent with that shown in Figure 1 of the '262 patent, in which the network device 1001 is directly connected to the printer. Accordingly, Applicants respectfully submit that the '262 patent fails to disclose the step of obtaining, by a first computer over the network, device information of at least one network device, wherein the first computer is remote from the at least one network device, and the first computer is the first computer to obtain the device information from at least one network device, as recited in Claim 1. The '262 patent does not disclose that the first computer obtains the device information over the network.

Claims 5 and 9 recite limitations analogous to the limitations recited in amended Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claims 5 and 9 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 5, and 9 (and all associated dependent claims) patentably define over any proper combination of the '262, '236, '179, '286, '247, and '289 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Kurt M. Berger

James J. Kulbaski
Registration No. 34,648
Attorney of Record
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

JJK/KMB/law
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